

### **REMARKS**

Claims 30-58 are pending in the application. Claims 30, 33-37, 43-46, 50-51, and 58 were rejected under 35 U.S.C. § 102. Claims 38-40 were rejected under 35 U.S.C. § 103.

The claims have now been amended. Claims 38-40 have now been cancelled. Reconsideration of the application is respectfully requested.

### **Claims 41, 42, 47-49 and 57**

It is unclear if claims 41, 42, 47-49 and 57 contain allowable subject matter or have not yet been examined on the merits. The Office Action states that these claims are "rejected as incorporating the deficiency of claim 31 upon which they depend." It is respectfully submitted that claim 31 does not include any deficiency. Although claim 31 was rejected, dependent claims 41, 42, and 47-49 include additional features, which the Examiner may consider allowable. Further, claim 57 does not depend from claim 31, as set forth below.

Applicant respectfully requests that the Examiner either explicitly state that claims 41, 42, 47-49 and 57 contain allowable subject matter or examine these claims on the merits in a new and favorable non-final Office Action.

### **Objections to the Claims**

Claim 57 was objected to for informalities. The Examiner believes the dependency of claim 57 is incorrect. Applicant respectfully traverses the objection. It is respectfully submitted that claim 57 properly introduces "a second detection unit." Accordingly, were claim 57 to depend from claim 31, it would be indefinite as claim 31 already introduces "a second detection unit." Withdrawal of the objection to claim 57 is respectfully requested.

### **Rejections Under 35 U.S.C. § 112**

Claims 52 and 53 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner states that the claims contain subject

matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.

Claim 52 recites "a shutter disposed in the first or second beam path in front of at least one of the first detectors configured to open for a detection." Claim 53 further recites that "the shutter is configured to close automatically as a function of an amount of light striking the at least one of the first detectors during the detection." It is respectfully submitted that the shutter and its functionality is described in the Specification, for example, at paragraph [0017]. Further, it is respectfully submitted that this description would enable one skilled in the art to make and/or use the invention. Shutters are well known. Further, because the first detectors detect light, based on the present specification, it would be within the ability of one of ordinary skill in the art to configure the shutter to close as a function of the amount of light striking the detector. Withdrawal of the rejection under 35 U.S.C. § 112, second paragraph is respectfully requested.

**Rejections Under 35 U.S.C. §§ 102 and 103**

Claims 30, 33-37, 43-46, 50-51, and 58 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,886,784 to Engelhardt. Claims 38-40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Engelhardt in view of U.S. Publication No. 2004/0042007 to Osipchuk et al. ("Osipchuk"). Claims 31, 32 and 54-56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Engelhardt.

Engelhardt describes a device which splits a beam of light into spectral components. One spectral region is cut out from the beam, while another region is reflected. Each region is detected by a respective detector. *See*, Engelhardt, column 2, lines 14-25.

Osipchuk describes a fluorescent optical imaging system that includes two detectors PMT 1 and PMT 2. The detectors may include PMT, photodiode, avalanche photodiode and other optical detectors. *See*, Osipchuk, paragraph [0037].

Independent claim 30 of the present application has now been amended so as to recite "a first one of the first detectors being disposed in a first beam path of the blocked second spectral

region” and “a second one of the first detectors being disposed in a second beam path of the reflected first spectral region,” and “each of the first and second first detectors having a respective different detection property or using a respective different detection method.” Both Engelhardt and Osipchuk fail to teach or suggest two detectors that have respective different detection properties or respective different detection methods as recited in claim 30. Claim 30 further recites “each of the first and second first detectors including at least one of: a photomultiplier configured to detect fluorescence, an arrangement of photodiodes configured for making quick measurements, and an arrangement of avalanche photodiodes configured for detecting weak signals.” As noted by the Examiner, Engelhardt does not teach the use of a photomultiplier, photodiode or avalanche photodiode. See Office Action, page 6, lines 11-12. Nor, it is respectfully submitted, does Engelhardt teach or suggest each of two detectors having a different detection property or using a respective different detection method. Engelhardt merely shows two detectors 31 and 32. See Engelhardt, Fig. 3. There is no disclosure in Engelhardt that detectors 31 and 32 have different detection properties or use respective different detection methods. Nor does Osipchuk teach or suggest each of two detectors having different detection properties or using a respective different detection method, nor such different detectors disposed in respective beam paths of respective spectral regions. Osipchuk merely describes that the two detectors PMT 1 and PMT 2 that receive light from different regions of a sample may include various types of detectors. See Osipchuk at paragraph 0037.

Because each of Engelhardt and Osipchuk fail to teach or suggest the above-recited features of independent claim 30, these references, either alone or in combination, could not anticipate or render obvious claim 30 or its dependent claims 31-57.

Claim 58 recites a scanning microscope with a plurality of first detectors, “each of the first detectors having a respective different detection property or using a respective different detection method.” As discussed above relative to claim 30, both Engelhardt and Osipchuk fail to teach or suggest two detectors that have respective different detection properties or respective different detection methods, as recited in claim 58. Thus, Engelhardt and Osipchuk, either alone or in combination, could not anticipate or render obvious claim 58.

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Reconsideration and withdrawal of the rejections under 35 U.S.C. §§ 102 and 103 is respectfully requested.

**CONCLUSION**

It is respectfully submitted that the application is now in condition for allowance.

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Respectfully submitted,

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